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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Low, et al.
App. No : 10/009,575
Filed : August 6, 2002
For : A MESSAGE PROCESSING SYSTEM
Examiner : CORRIELUS, JEAN M
Art Unit : 2162

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John M. Carson, Reg. No. 34,303

REPLY TO EXAMINER'S ANSWER

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is in response to the Examiner's Answer dated October 7, 2008 in the above-captioned application.

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I. STATUS OF THE CLAIMS

An Appeal Brief, which included a Status of the Claims, was filed on August 18, 2008, which is hereby incorporated by reference. In an Examiner's Answer to the Appeal Brief dated October 7, 2008, the Examiner submitted a new ground of rejection for Claims 29-35 under 35 U.S.C. § 101 stating the claimed invention is directed to non-statutory subject matter. Further in the Examiner's Answer, the Examiner maintained the rejection of Claims 19-36 based on the same references (Olivier and Ogilvie).

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II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

This Appeal turns on the following issues:

Claims 29-35 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 19-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Olivier, et al. (U.S. Patent No. 6,480,885) and Ogilvie, et al. (U.S. Patent No. 6,324,569).

III. APPELLANT'S ARGUMENT

A. Claims 29-35 Recite Patentable Subject Matter

i) The Examiner's Ground for Rejection

In the Examiner's Answer, the Examiner makes a new ground for rejection stating that Claims 29-35 constitute unpatentable subject matter under 35 U.S.C. § 101. As a basis for the rejection, the Examiner states in the Examiner's Answer at pg. 3 that Claim 29 is directed toward a "a message processing system," and that the system as claimed is "not part of a computer device" and therefore is software per-se and is non-statutory under 35 U.S.C. § 101.

The Examiner also states that Claim 30 recites a message processing system and that such system is "not embedded in a physical hardware to perform the elements as claimed."

The Examiner states that the use of the word system "does not inherently mean that the claim is directed to a machine." Further, the Examiner states that through review of the specification, the system may be reasonably implemented as software routines and that software per se is non-statutory under 35 U.S.C. § 101 because it is merely a set of instructions without any defined tangible output or tangible result being produced as required in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47USPQ2d 1596 (Fed. Cir. 1998). Appellant respectfully disagrees.

ii) The Legal Standard

The Federal Circuit recently articulated in *In re Bilski*, 88 U.S.P.Q.2d 1385 (2008), that the "'useful, concrete and tangible result' inquiry is inadequate." The case was decided on October 30, 2008, which is after the Examiner's Answer dated October 7, 2008, and therefore has not been considered by the Examiner. The Federal Circuit articulated the "machine-or-transformation" test, according to which a claimed process is patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. *Id.* It should be noted that the claims at issue in *In re Bilski* were directed toward a process and not a machine as in the present application, and therefore may not

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apply to the present claims, such that the claims need not be tied to a particular machine. Though footnote 18 of the *In re Bilski* decision acknowledges that the decision in *State Street Bank & Trust Co.* was directed to a means-plus-function claim and the court in *In re Bilski*, then concluded the “useful, concrete and tangible result” test of *State Street Bank & Trust Co.* was inadequate, it did not specifically hold the test in *In re Bilski* applies to means-plus-function claims. The court has, however, made clear that the “useful, concrete and tangible result” test of *State Street Bank & Trust Co.* is no longer adequate.

Appellant respectfully submits that Claims 29 and 30 are patentable subject matter as machines and therefore patentable subject matter under 35 U.S.C. § 101.

iii) Claims 29-35 are not Software Per-Se and Constitute Patentable Subject Matter

Appellant respectfully disagrees with the Examiner’s assertion, that Claims 29 and 30 are software per-se and not patentable subject matter. Claims 29 and 30 are machine claims that follow the requirements of 35 U.S.C. § 101. The section instructs that:

Whoever invents or discovers any new and useful process, *machine*, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. (Emphasis Added)

Specifically, Claim 29 is a means-plus-function claim that follows the requirements of 35 U.S.C. § 112, paragraph 6. This paragraph instructs that:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

A “machine” claim having “means” clauses may only be reasonably viewed as a process claim if there is no supporting structure in the written description that corresponds to the claimed “means” elements. See *In re Alappat*, 33 F.3d 1526, 1540-41, 31 USPQ2d 1545, 1554 (Fed.Cir.1994) (in banc).

The relevant specification and figures of Appellant's application illustrate the supporting structure as follows:

A message processing system 2, as shown in Figure 1, is provided by a computer which may be a Unix server. The system 2 includes standard web server software 8 and e-mail server software 12 so that the system 2 can operate as a web server and can also operate as an e-mail server, i.e. a standard POP3/SMTP/IMAP e-mail server. The system 2 also includes e-mail manager software 10 stored on the server which includes program code and database code that establishes a database on the server 2. The code of the manager 10 causes the system to execute the message handling steps described below. Although shown on one machine, it will be understood by those skilled in the art that software components 8, 10 and 12 of the system 2 can be distributed amongst a number of machines in different locations, provided the components 8, 10 and 12 can communicate with one another, as shown in Figure 1. Also it will be understood that the e-mail manager could be provided at least in part by application specific integrated circuits (ASICs) which execute the steps of the message handling process. (page 2, line 22 to page 3, line 3).

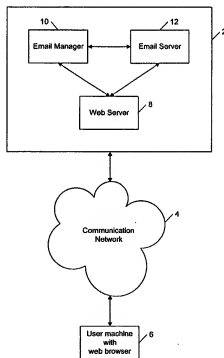


FIG. 1

Specifically, the specification refers to a message processing system 2 provided by a computer which may be a Unix server (page 2, lines 22-23; Figure 1). Further the specification refers to embodiments where the system can be distributed among a number of machines in different locations (page 2, lines 28-30). The specification also states that the e-mail manager could be provided at least in part by application specific integrated circuits (ASICs) which execute the message handling process (page 3, lines 2-3). In sum, the supporting structure for the various means limitations of Claim 29 can be at least any of a Unix based server, a distributed system of machines, or ASICs and equivalents thereof. Therefore, under *In re Bilski*, Applicant respectfully submits that Claim 29 is tied to a particular machine or apparatus, as described above, and therefore the claim is statutory subject matter.

Further, Claim 30 recites a message processing system comprising an electronic message server and an electronic message manager. The electronic message server and electronic message manager are supported by particular machines in the specification, specifically the Unix server (page 2, lines 22-23), the machines in different locations (page 2, lines 28-30), and the ASICs (page 3, lines 2-3). The phrase electronic message server itself contains the word *server*, which is “a computer in a network that is used to provide services (as access to files or shared peripherals or the routing of e-mail) to other computers in the network” (e.g., Unix based system). *Merriam-Webster Online Dictionary* (December 2008). A computer is a known type of machine. Therefore, Applicant respectfully submits that Claim 30 is tied to a particular machine and thus the claim is statutory subject matter.

iv) Conclusion

In view of the foregoing, Appellant respectfully requests reconsideration and withdrawal of the rejection of Claims 29-35.

B. Claims 19-36 are Patentable over Olivier and Ogilvie.

i) The Examiner's Grounds for Rejection

In the Examiner's Answer, it is maintained that Claims 19-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Olivier, et al. (U.S. Patent No. 6,480,885) and Ogilvie, et al. (U.S. Patent No. 6,324,569). In rejecting the claims, the Examiner acknowledges that Olivier does not explicitly notify the recipient if the message is unapproved. The Examiner uses Ogilvie to try to cure this deficiency.

ii) Neither Olivier nor Ogilvie Teaches or Suggests the Features of Each of Pending Claims 19-36

a. Discussion of Patentability of Independent Claims 19, 29, 30 and 36

Each of independent Claims 19, 29, and 36 recites, among other things, "notifying the recipient and storing the message, if the message is unapproved." Claim 30 includes a similar feature of "an electronic message manager for ... storing and sending a notification to the recipient of unapproved messages." As such, Claims 19, 29, 30 and 36 are discussed together in this section.

1. The provisional applications of Ogilvie (the '138 and '517 applications) do not disclose the claimed feature of: "notifying the recipient and storing the message, if the message is unapproved."

The provisional applications of Ogilvie, which are necessary to antedate the priority date of Appellant's application, do not disclose the notification and storage features recited in Claim 19 of: notifying the recipient and storing the message, if the message is unapproved.

In the Examiner's Answer at pg. 14, the Examiner states that Ogilvie discloses an email verification system for notifying the recipient if the message is approved (column. 14, lines 26-

39). Further, the Examiner states that Ogilvie '138 discloses the possibility of a reply is an explicit option presented to the user allowing the user to request removal as it was a notification as to whether the message is approved or unapproved (page 4, lines 5-15). The Examiner also states that Ogilvie '517 discloses the email message does not initially delete itself after displaying the message and is instead modified based on the notification request by the recipient (page 10, lines 1-2, and page 12, lines 1-4). The Examiner goes on to state that the system disclosed by Ogilvie checks the incoming messages to determine whether they contain a self-removing messaging indicator from the message originator or message distributors and automatically notifies the recipient. Appellant respectfully disagrees for the following reasons.

First, with regard to the '138 application, the Examiner states that "a self-removing email file's self-removal property can be expressly overridden" and in some cases the recipient is automatically notified of the override (page 4, lines 5-15). In particular the '138 application recites:

a self-removing email file's self-removal property can be expressly overridden by the sender, by the recipient, by an intervening authority such as an ISP or an authorized government agency, or by some combination of these. In some cases, the override is silent, and in others the sender or recipient or both are automatically notified of the override.

In some embodiments, a reply email (self-removing or not) is sent automatically to the sender when the recipient has opened the self-removing email message. In some, the possibility of a reply is an explicit option presented to the user; in some of these cases, the options presented include one to send a reply asking that the recipient be removed from the mailing list. This allows the user to request removal by doing little or nothing more than opening the unsolicited message and clicking on a "REMOVE FROM MAILING LIST" box or button. (page 4, lines 4-15).

In the case where a recipient opens a self-removing email, there is an express option for the recipient to reply and be removed from a mailing list. The only notification given to the recipient is that the self-removal property has been overridden (page 4, lines 4-7). There is no notification with regard to whether the message is "approved" or not (self-deleting or not), but

rather whether another individual has changed the self-removing e-mail property. Further, nowhere in this language is storage of an unapproved message recited. Therefore, the '138 application fails to teach or suggest notifying a recipient and storing the message, if the message is unapproved.

Second, with regard to the '517 application, the Examiner refers to an embodiment where the displayed message does not initially delete itself but "self-modifies to become a searcher" which no longer contains the message content and merely seeks and destroys copies of the message (page 10, lines 1-2; and page 12, lines 1-4). The '517 application recites in relevant part:

One embodiment does not initially delete itself after displaying the message. Instead, the message file self-modifies to become a searcher. The searcher has a limited life span, measured either by elapsed time since its inception or by the number of times the searcher or its direct ancestors have been launched for execution.

Thus, the first time the message file is run, it displays the message, *overwrites the message content*, and notes internally that it has done so. (Emphasis Added) (page 10, lines 1-6).

Specifically, the first time the message file is run, it displays the message, and then *overwrites* the message content (page 10, lines 5-6). This teaches away from the claim which recites "notifying the recipient and storing the message, if the message is unapproved" because the cited embodiment displays the message without any particular notification and then deletes the message if there is an unapproved message, instead of storing the unapproved message. Therefore, the '517 application also fails to teach or suggest notifying a recipient and storing the message, if the message is unapproved.

Accordingly, Appellant respectfully requests withdrawal of the §103(a) rejection and allowance of Claims 19, 29, 30, 36.

b. Discussion of Patentability of Dependent Claims 20-28 and 31-35

Although Appellant has not addressed all the issues of the dependent claims, Appellant respectfully submits that Appellant does not necessarily agree with the characterization and

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assessments of the dependent claims made by the Examiner, and Appellant believes that each claim is patentable on its own merits. The dependent claims are dependent either directly or indirectly on one of the above-discussed independent claims. Appellant respectfully submits that pursuant to 35 U.S.C. § 112, ¶4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Appellant respectfully requests withdrawal of the §103(a) rejection and allowance of Claims 20-28 and 31-35.

iii) Conclusion

In view of the foregoing, neither Olivier nor Ogilvie, alone or in combination teach all the features of independent Claims 19, 29, 30 and 36. Appellant respectfully requests reconsideration and withdrawal of the rejection of Claims 19-36.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.



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